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09/682,891	10/30/2001	Frank A. Smith	GEPL.P-033	2327
43247	7590	06/25/2007		
Marina Larson & Associates LLC			EXAMINER	
re: lexan			OSMAN, RAMY M	
PO BOX 4928				
DILLON, CO 80435			ART UNIT	PAPER NUMBER
			2157	
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			06/25/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/682,891

Applicant(s)

SMITH, FRANK A.

Examiner

Ramy M. Osman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is responsive to RCE amendment filed on April 19, 2007, where applicant amended claims 1 and 8 to overcome minor informalities. Claims 1-13 are pending.

Response to Arguments

2. Previous objections to claims 1 and 8 are withdrawn.
3. Applicant's arguments filed 4/19/2007 have been fully considered but they are not persuasive.
4. Applicant argues that the "unilateral license" of the claim is distinguishable from the "digital license" disclosed by Corless. Applicant relies upon paragraphs 2,4 & 5 of Applicants specification and upon Figure 6 of Applicants drawings, to illustrate the differences between the licenses.

In reply, it is noted that the features upon which applicant relies (i.e., the particulars of Applicants specification) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 1-5,7,8,12,13 are rejected under 35 U.S.C. 102(e) as being anticipated by**

Corless (U.S. Patent No. 5,991,751).

7. As to claim 1, Corless teaches a method for patent licensing which comprises:

(a) providing a web site listing a plurality of patents available for unilateral license

(column 6 lines 1-25 and column 7 lines 1-5);

(b) providing on the web site at least one unilateral license form associated with at least one listed patent (column 7 lines 1-10 and column 8 lines 1-10); and

(c) providing a means on the web site for a user to accept a unilateral license for a listed patent (column 7 lines 1-10 and column 8 lines 1-10).

8. As to claim 2, Corless teaches the method according to claim 1, wherein the web site does not require a sign-in procedure on the part of any potential licensee (column 6 lines 1-35, the web site of Corless does not have a sign-in feature and therefore it is inherently taught that no sign-in procedure is required).

9. As to claim 3, Corless teaches the method according to claim 2, which further comprises providing a copy of the unilateral license which can be viewed by any potential licensee without a potential licensee having to indicate interest in a particular listed patent (column 7 lines 1-10 and column 8 lines 1-10).

10. As to claim 4, Corless teaches the method according to claim 3, which further comprises providing a list of patents available for unilateral license which can be viewed by any potential

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licensee without a potential licensee having to indicate interest in a particular listed patent (column 7 lines 1-10).

11. As to claim 5, Corless teaches the method according to claim 2, which further comprises sending an acknowledgement form to a licensee after said licensee indicates acceptance of a unilateral license (column 8 lines 1-7).

12. As to claim 8, Corless teaches the method according to claim 1, wherein a first listed patent is associated a first unilateral license and a second listed patent is associated with a second unilateral license, which second unilateral license differs from the first unilateral license (column 7 lines 1-10).

13. As to claim 12, Corless teaches the method according to claim 1, wherein a listed patent is associated with a plurality of unilateral licenses (column 5 lines 50-67 and column 6 lines 20-67).

14. As to claim 13, Corless teaches the method according to claim 12, wherein the listed patent is associated with at least one exclusive unilateral license (column 5 lines 50-67).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. **Claims 7,9-11 rejected under 35 U.S.C. 103(a) as being unpatentable over Corless (U.S. Patent No. 5,991,751) in view of Johnson et al (US Patent No 5,991,876).**

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17. As to claim 7, Corless teaches the method according to claim 1 wherein at least one unilateral license form associated with a listed patent is an exclusive unilateral license form (column 5 lines 50-67 and column 6 lines 20-67). Corless fails to explicitly teach in which method further comprises indicating on the web site that the listed patent is no longer available for licensing if a licensee has indicated acceptance of an exclusive unilateral license for said listed patent. However, Johnson teaches that it is well-known where intellectual property rights are no longer available for licensing if a licensee has been granted an exclusive unilateral license for the intellectual property (column 1 lines 5-10 and column 2 lines 5-10).

It would have been obvious for one of ordinary skill in the art to modify Corless in which method further comprises indicating on the web site that the listed patent is no longer available for licensing if a licensee has indicated acceptance of an exclusive unilateral license for said listed patent as per the teachings of Johnson for the purpose of granting an exclusive unilateral license for intellectual property.

18. As to claim 9, Corless teaches the method according to claim 1. Corless fails to explicitly teach wherein the unilateral license form lists different initial royalty payments that are dependent on the age of the listed patent. However, Johnson teaches fees associated with intellectual property for the purpose of rights management and authorization (column 7 lines 48-51 and column 8 lines 8-22).

It would have been obvious for one of ordinary skill in the art to modify Corless wherein the unilateral license form lists different initial royalty payments that are dependent on the age of the listed patent as per the teachings of Johnson for the purpose of rights management and authorization for intellectual property.

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19. As to claim 10, Corless teaches the method according to claim 1, wherein a royalty can be calculated according to the unilateral license form (Johnson, column 7 lines 48-51 and column 8 lines 8-22).

20. As to claim 11, Corless teaches the method according to claim 1, wherein a royalty is listed on the web site and the unilateral license form refers to the royalty listed on the web site (Johnson, column 7 lines 48-51 and column 8 lines 8-22).

21. **Claim 6 rejected under 35 U.S.C. 103(a) as being unpatentable over Corless (U.S. Patent No. 5,991,751) in view of Lockhart et al (US Patent No 6,944,776).**

As to claim 6, Corless teaches the method according to claim 4. Corless fails to explicitly teach further comprises sending an invoice to a licensee after said licensee indicates acceptance of a unilateral license. However, Lockhart teaches transmitting an invoice to a consumer after consumer accepts data rights (column 5 line 55 – column 6 line 10, column 30 line 60 – column 31 line 5 and column 31 lines 35-40).

It would have been obvious for one of ordinary skill in the art to modify Corless by sending an invoice to a licensee after said licensee indicates acceptance of a unilateral license as per the teachings of Lockhart for the purpose of managing the sale of intellectual property rights.

Conclusion

22. Applicant is advised that the above specified citations of the relied upon prior art are only representative of the teachings of the prior art, and that the entirety of the reference (including any figures, incorporation by references, and claims) is being applied to teach the scope of the

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claims. It is respectfully requested that applicant consider the reference as a whole when preparing a response.

23. This is a continuation of examination of Applicants application. All claims are drawn to the same invention and limitations as claimed earlier and are rejected on the grounds and art already made of record. Applicant has not presented anything new in this amendment.

Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case.

See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramy M. Osman whose telephone number is (571) 272-4008. The examiner can normally be reached on M-F 9-5.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RMO

June 19, 2007


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